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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,096	06/15/2001	Brian E. Joseph	1474(Touchstone)	7698

30010 7590 12/19/2002

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EXAMINER

VO, HAI

ART UNIT	PAPER NUMBER
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1771

5

DATE MAILED: 12/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/882,096

Applicant(s)

JOSEPH ET AL.

Examiner

Hai Vo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-19 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2,3,5-12 and 14-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. Claim 1 has been canceled in the amendment received on 10/07/2002.

Election/Restrictions

2. Applicant's election with traverse of claims 1-3, 5-12 and 14-18 in Paper No. 4 is acknowledged. The traversal is on the ground(s) that there is no element in claim 2 would limit Applicant to a claim to only a metallic species. This is not found persuasive because the multi-void core comprises a member that can be selected either metal **or** polymer species and these two species are patentably distinct (see rejections below). If claim 2 recites the multi-void core can be made of metal **and** polymer, Applicant can further limit the nature of the multi-void core to both metal and polymer species.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 2, 3, 5, 6 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Dobson (US 4,257,481). Dobson discloses a heat exchange element comprising a multi-void core 4 having two planar surfaces and at least one layer of a composite stiffening material 10 attached to each of the two planar surfaces (figures 1 and 5). Dobson discloses the multi-void core comprising the ducting made of copper (column 3, lines 5-7). With regard to claim 5, It is the examiner's

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position that the solar heating element of Dobson is identical to the claimed composite sandwich prepared by the method of the claim, because both articles use the same materials, having structural similarity (node-fibril microstructure). Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). The Dobson reference either anticipated the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Dobson.

With regard to claim 6, the composite stiffening material is made of a glass reinforced plastics material (column 3, lines 65-68). It is the examiner's position that Dobson anticipates the claimed subject matter.

Claim Rejections - 35 USC § 103

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 3, 5-12, and 14-19 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Schubert et al (US 6,305,834) in view of Schuster et al (US 4,987,003). Schubert discloses a device having a multi-void core of metal foil having two planar surfaces and including a plurality of continuous, parallel, longitudinal channels 13, 14. Schubert is silent as to the layers of a composite stiffening material coated onto two planar surfaces of the multi-void core.

Schuster teaches a composite having a metal matrix composite coating provided on the metal surface to provide a corrosion and mechanical wear resistance coating (abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the metal matrix coating onto the surface of the multi-void core motivated by the desire to provide a corrosion and mechanical wear resistance coating.

With regard to claims 5 and 14, see product-by-process rational with respect to claim 5 in the paragraph no. 4.

With regard to claims 9 and 18, Schuster teaches the metal matrix composite comprising ceramic particles (column 2, lines 3-9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ

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the solid fillers in the metal matrix coating onto the surface of the multi-void core motivated by the desire to increase the strength of the coating.

Response to Arguments

7. Applicant's arguments with respect to claims 1-3, 5-12, and 14-18 have been considered but are moot in view of the new ground(s) of rejection.
8. The art rejections in Paper no. 3 have been overcome by the present amendment and response.
9. Applicant states that there is no specific basis of rejection of claim 9 in the last Office Action. The rejections of claim 9 would have been included together with the rejections of claim 18 because both claims recite the identical limitation of ceramic fibers in the metal matrix composite. The examiner would like to apologize for any inconvenient that may have been caused.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory

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action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Tue-Fri, 8:30-6:00 and on alternating Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV
December 15, 2002


TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700